

Remarks

Claims 1-54 are currently pending in the instant application. The present Office Action includes rejections under 35 U.S.C. §112, §102 and §103, and a provisional obviousness-type double patenting, responses to which are discussed below. Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested.

Claim 1 is being amended to recite the subject matter of old claims 4 and 5. Claim 2 has been amended to more fully describe the invention. Support for the amendment can be found on page 4, lines 24-28, and page 15, lines 7-8, 12-13, and 24-32. Claims 4 and 5 are being deleted as the subject matter of these claims are now included in newly amended claims 1 and 2. Claim 36 has been amended in manner similar to that of claim 2. Claim 41 has been amended in a manner similar to that of claim 1. Claim 42 has been amended in manner similar to that of claim 2. New claims 55-62 are being added. Support for these claims can be found on page 1, lines 16-17, 30-34 and page 4, lines 29-30. No new matter has been added by these amendments.

Rejection under 35 U.S.C. §112, 2nd Paragraph

It is unclear whether the rejection of claim 5 under 35 U.S.C. §112, second paragraph, has been maintained. Applicants point out that claim 5 is now being cancelled, and its subject matter is being incorporated into new claim 1. Applicants respectfully request clarification.

Rejections under 35 U.S.C. §102(b)

Grebow:

Claims 1-4, 6, 32, 33, 36, 37, 39, 41-44, 47, 48, and 51 remain rejected under 35

U.S.C. §102(b) as being anticipated by Grebow et al.

Newly amended claim 1 now reflects the subject matter of old claim 5, which was not subject to any novelty rejection. Claims 36, 41 and 42 have similarly been amended to include the same limitation. Hence, Applicants submit that newly amended claims 1, 36, 41 and 42 and their corresponding dependent claims are novel over Grebow.

Newly amended claim 2 has been modified to refer to compositions that are optically isotropic. Applicants respectfully submit that this element is not taught in Grebow. Claims 36 and 42 was similarly amended. Since Grebow does not teach all the elements of the instant claims, Applicants respectfully submit that newly amended claims 2, 36, and 42 and their dependent claims are novel over Grebow.

Hence, Applicants respectfully request entry of the amendments and remarks, and reconsideration and withdrawal of the novelty rejection with respect to Grebow.

Nguyen:

Claims 1-4, 6, 11, 14, 15, 32, 33, 36, 37, 39, 47, 51, and 54 remain rejected under 35 U.S.C. §102(b) as being anticipated by Nguyen et al.

Newly amended claim 1 now reflects the subject matter of old claim 5, which was not subject to any novelty rejection. Claim 36 has similarly been amended to include the same limitation. Hence, Applicants submit that newly amended claims 1 and 36 and their dependent claims are novel over Nguyen.

Newly amended claims 2 and 36 have been modified to refer to compositions that are optically isotropic. Applicants respectfully submit that Nguyen fails to teach compositions that are optically isotropic. Indeed the “emulsions” taught in Nguyen are prepared as “pasty mixtures” with a particular degree of viscosity (*See* Nguyen, abstract, claim 1, col. 5, lines 3-9, and elsewhere). Since Nguyen does not teach all the elements of the instant claims,

Applicants respectfully submit that newly amended claims 2 and 36 and their dependent claims are novel over Nguyen.

Hence, Applicants respectfully request entry of the amendments and remarks, and reconsideration and withdrawal of the novelty rejection with respect to Nguyen.

Rejection under 35 U.S.C. §103(a)

Claims 17, 18, 34, 35, 38, 45, 46, 49, 50 and 53 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Grebow, et al., and claims 8-10, 13, 17-20, 34, 35, 38, and 40-46 are similarly rejected over Nguyen, et al. in view of Lafon.

Applicants respectfully submit, for the reasons stated above, that the references, either alone, or in combination, fail to teach the subject matter of the instant claims. Applicants further submit that Lafon does not cure the deficiencies of Nguyen. Since neither Grebow, nor Nguyen in view of Lafon teach the disclosure of the instant application, Applicants respectfully submit that the instant claims are non-obvious.

Hence, Applicants respectfully request entry of the amendments and remarks, and reconsideration and withdrawal of the rejections under §103.

Double Patenting Rejection

Claims 1, 3-5, 14-15, 32-34 and 35 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-3, 7, 8, 10-13, and 26-29 of copending Application No. 09/974,473.

Copending application No. 09/974,473 has now issued as U.S. Pat. No. 6,489,363. Applicants submit that the instant claims are not obvious in view of the '363 patent. The '363 patent teaches *solutions* of modafinil compounds, where the modafinil compounds are

dissolved in solution. There is no teaching in the '363 patent that the modafinil compounds form "particles", as defined in the instant application. (See Specification, page 4, lines 20-23: "particle" or "particles" refers to substantially non-crystalline structures, preferably an aggregation of molecules in a discrete non-crystalline structure, such as a micelle, microsphere, droplet, colloid, or globule.""). Since the '363 patent does not teach the particle-forming compositions and the composition of particles claimed in the instant application, Applicants respectfully submit the instant claims are not obvious over the '363 patent.

Hence, the double patenting rejection is improper, and Applicants respectfully request withdrawal of the rejection.

Conclusion

In view of the above, it is requested that the amendments and remarks be entered. It is believed that all the claims are in form for allowance, and an early notification to that end is respectfully requested. Applicants invites the Examiner to contact the undersigned at (610) 738-6465 to clarify any unresolved issues raised by this response.

Respectfully submitted,



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